

Serial No.: 10/827,476
Inventor(s): Higgins et al.

JUL 23 2007

U.S. PTO Customer No. 25280
Case No.: 5615B

REMARKS*The Pending Claims*

Claims 1 and 50 have been amended and Claim 19 has been cancelled without prejudice or disclaimer. Thus, Claims 1-11, 20-24, 27-30, 33-36, 38-39, 42-43, and 50 are currently pending. Claims 1 and 50 have been amended to call for at least one layer of foam cushioning.

Summary of the Office Action

The Office Action dated February 22, 2007, included the following rejections, objections, and comments:

1. Claim 19 was rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement.
2. Claims 33-36 were rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement.
3. Claims 42, 43, and 50 were rejected under 35 U.S.C. 112, first paragraph, for failing to comply with the enablement requirement.
4. Claims 1, 5, 6, 20, 42, 43, and 50 were rejected under 35 U.S.C. 102(b) as being anticipated by Lukowski, Sr. (US Patent 5,972,148).
5. Claims 21-24 were rejected under 35 U.S.C. 102(b) as being anticipated by, or under 35 U.S.C. 103(a) as obvious over Lukowski, Sr. (US Patent 5,972,148).
6. Claims 2-4 were rejected under 35 U.S.C. 102(b) as being anticipated by, or under 35 U.S.C. 103(a) as obvious over Lukowski, Sr. (US Patent 5,972,148).
7. Claims 7-11, 27-30, and 38 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lukowski, Sr. (US Patent 5,972,148).
8. Claim 39 was rejected under 35 U.S.C. 103(a) as being unpatentable over Lukowski, Sr. (US Patent 5,972,148), in view of Bahlo (US Patent 3,847,647).

In response to these rejections and in view of the above Amendments, Applicants provide the following Remarks:

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Discussion

Claims 33-36 were rejected for failing to comply with the enablement requirement. In particular, the Office Action stated that while the specification provides support for a surface covering element comprising a carpet show surface having an underside of PVC, the specification does not enable a surface covering element comprising vinyl, ceramic, laminate, or wood show surface having a PVC underside. Applicants respectfully disagree with this rejection.

The specification is directed towards surface coverings that should be readily removable after initial placement across the sub floor so as to permit repositioning and/or subsequent replacement as desired. While PVC backing layers were described in the Figures with relation to only carpet-type show surfaces, it is clear from the specification, for example, page 28, lines 22-29, that the different constructions can be utilized with many different show surfaces and that the carpet-type show surface was used as an example:

"It is also contemplated that a wide range of surface covering element constructions other than pile fabric may be utilized. By way of example only, and not limitation, various other constructions include surface coverings of woven or non-woven fabric (including woven, knit, flocked, and needle punched fabrics and the like) hardwoods, ceramic tile (and veneers emulating hardwoods and ceramic tile), glass, vinyl composite tile, stone (such as marble, granite and the like), slab-like decorative composites such as CORIAN® and the like as well as decorative laminate sheeting such as linoleum and the like."

Applicants respectfully believe that the specification enables one skilled in the art to make and/or use different backing layers described with the different show surfaces described. (For example, page 28, lines 21 – 32; page 29, lines 1 – 7 and 30 – 33; page 30, lines 1 – 28; and Figures 24 – 29.)

Further, claim 19 was rejected for failing to comply with the enablement requirement. In particular, the Office Action stated that while the specification provides support for a surface covering element comprising a carpet show surface having at least one layer of foam cushioning, the specification does not enable a surface covering element comprising vinyl, ceramic, laminate, or wood show surface having a foam cushioning layer. Additionally, Claims 42, 43, and 50 were rejected for failing to comply with the enablement requirement. In particular, the Office Action stated that while the

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specification provides support for a surface covering element comprising a carpet show surface having an underside of felt, the specification does not enable a surface covering element comprising vinyl, ceramic, laminate, or wood show surface having a felt underside. Applicants respectfully disagree.

In addition to the line of reasoning presented above that different constructions can be utilized with many different show surfaces other than the carpet-type show surface example, the specification describes constructions using the show surface being wood, ceramic, vinyl, or laminate on, for example, page 29 line 30 through page 30 line 28 and in Figures 27 through 29. The specification describes constructions with wood as the show layer:

"An alternative construction which utilizes a wood or wood veneer show surface 1850 is set forth at FIG. 27 wherein elements corresponding to those previously described are designated by like reference numerals within an 1800 series... If desired, one or more intermediate layers of felt, foam or combinations thereof may be disposed between the wood or wood veneer show surface 1850 and the friction enhancing composition 180." (page 29, line 30 – page 30, line 6)

The specification makes clear that addition layers of foam and/or felt may be used between the wood veneer and the friction enhancing composition and would correspond to previously described constructions as foam and felt layers in other constructions have been laid out with other show surfaces. The paragraphs on, for example, page 30 lines 8 through 28 describe the same construction details and additional embodiments with respect to vinyl, laminate, and ceramic. Therefore, Applicants respectfully believe that a surface covering element comprising a vinyl, ceramic, laminate, or wood show surface having a foam cushioning layer or a felt layer are supported by the specification.

Claims 19 and 33 – 36 were not rejected under art. Hence, Applicants respectfully believe that at least claims 1, 33 – 36, and 50 are allowable as the 112 rejections have been obviated and claims 1 and 50 contain the limitation of the cushioning layer of claim 19.

Claims 1-11, 20-24, 27-30, 38, 42, 43, and 50 were rejected as being anticipated by, obvious, or unpatentable over Lukowski, Sr. As amended claims 1-11, 20-24, 27-30, 38, 42, 43, and 50 have the recitation that the surface covering element includes at

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least one layer of foam cushioning. Applicants respectfully believe that Lukowshi, Sr. does not teach, suggest, or disclose the use of a foam layer.

Claim 39 was rejected as being unpatentable over Lukowski, Sr. in view of Bahlo. Applicants respectfully believe that the addition of Bahlo does not cure the deficiencies of Lukowski, Sr. as described above.

The claimed surface covering elements of the present application are especially suited to not require a cover layer. Such cover layers are used on peel-n-stick type flooring such as described in Lukowski, Sr. For example, Claim 1 of the present application calls for a friction enhancing coating composition with little or no blocking. A non-blocking composition does not require a cover sheet.

Conclusion

In view of the forgoing Amendments and Remarks, the Examiner is respectfully requested to pass the subject application to Allowance.

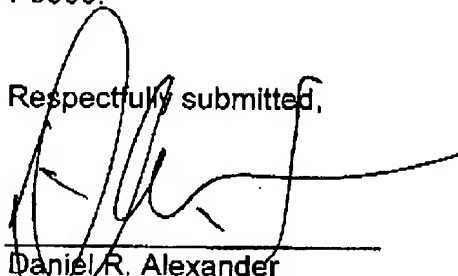
Fee Authorization: In the event that there are additional fees associated with the submission of these papers, Applicants hereby authorize the Commissioner to withdraw those fees from our Deposit Account No. 04-0500.

Extension of Time: In the event that additional time is required to have the papers submitted herewith for the above referenced application to be considered timely, Applicants hereby petition for any additional time required to make these papers timely and authorization is hereby granted to withdraw any additional fees necessary for this additional time from our Deposit Account No. 04-0500.

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